REMARKS/ARGUMENTS

Claims 1, 3-17, 19-25, 27-31, and 33-37 are pending in the present application. In the Office Action mailed June 14, 2005, the Examiner rejected claims 1, 3-17, 19-25, 27-31, and 33-37 under 35 U.S.C. §103(a).

In the light of present paper, including the amendments and remarks contained herein, reconsideration and allowance of the pending claims is respectfully requested.

I. Rejection of Claims 1, 3-17, 19-24, 31, and 33-37 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 3-17, 19-24, 31, and 33-37 under 35 U.S.C. §103(a) based on U.S. Patent No. 5,634,114 to Shipley (hereinafter "Shipley") in view of U.S. Patent No. 6,185,734 to Saboff *et al.* (hereinafter "Saboff") and in further view of U.S. Patent No. 5,590,056 to Barritz (hereinafter "Barritz"). *See e.g.*, Office Action, pp. 3. This rejection is respectfully traversed.

The M.P.E.P. states that

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. §2142.

In the present case, independent claims 1, 17, and 31 have been amended to recite that "the conflict between the selected application program and the software code is confirmed after the loading or execution of the software code has been detected." This claim element is not disclosed or suggested by any of the cited references. The only reference that arguable teaches anything related to a step of "confirming the conflict" is Shipley. *See* Office Action, p. 5. However, with respect to this matter, Shipley teaches as follows:

> Sometime after the application starts its execution (step 7), an initial call to the DLL is made (step 8). In initial DLL call 8 the application program passes the value of preferred version number 9 to the DLL. Preferred version number 9 is derived from header file 2 during the translation of application executable file 5. Preferred version number 9 specifies the version of the DLL program that the application prefers to work with, as was specified in header file 2 at the time compiler/assembler 4 translated the application program.

> In response to this initial DLL call, the DLL looks up preferred version number 9 in its version table (step 10). Step 11 decides whether or not preferred version 9 is supported, based on whether or not it is found in the DLL's table of versions that it supports.

Col. 6, lines 23-36.

According to the Examiner, Shipley's teaching regarding "look[ing] up [the] preferred version number ... in the table" constitutes the claimed "confirming step." However, to the extent that this interpretation is correct, this "look[ing] up" step is not done after the loading or execution of the software code has been detected. Rather, such looking up in the table occurs after the application has made an initial call to the DLL to inform the DLL of the preferred version number. *See also* Col. 7, lines 5-18. In fact, the very purpose of Shipley's "look[ing] up" step is so that the non-preferred software code will not be loaded or executed in the first place. *See* Shipley Col. 7, lines 12-18 (prior to the software code being used, "the DLL discovers that the preferred version [of the application program] is not supported" at which point ... "the DLL returns to the application a 'not OK' or 'preferred version not supported' flag"). In fact, the purpose of Shipley's invention is to allow the

application program to "confirm" this conflict to ensure that this conflicted software code in the DLL will never be used by the application. *See id.*; *see also* Shipley, Col. 7, lines 12-55.

As such, Shipley will never have situation in which the conflict between the software code and the application program is confirmed prior to the time in which the loading or execution of the software code is detected by the system. Therefore, because Shipley (or any of the other cited references) fails to teach or disclose a system in which the confirming step occurs after the loading or execution of the software code has been detected, this combination of references cannot render independent claims 1, 17, 25, and 31 *prima facie* obvious under 35 U.S.C. §103(a). Applicants respectfully request that this rejection be withdrawn.

Claims 3-16 depend, either directly or indirectly, from independent claim 1. Likewise, claims 19-24 depend, either directly or indirectly, from independent claim 17. Finally, claims 33-37 depend, either directly or indirectly, from independent claim 31. Accordingly, Applicants respectfully request that the rejection of these dependent claims based upon the combination of Shipley, Saboff, and Barritz be withdrawn for at least the same reasons as those presented above in connection with claims 1, 17, and 31.

Thus, withdrawal of the above-recited rejection is respectfully requested.

II. Rejection of Claims 25 and 27-30 Under 35 U.S.C. §103(a)

The Examiner rejected claims 25 and 27-30 under 35 U.S.C. §103(a) based on Shipley in view of Saboff and Barritz and in further view of U.S. Patent No. 5,960,204 to Yinger *et al.* (hereinafter "Yinger"). *See* Office Action, p. 12. This rejection is respectfully traversed.

As noted above, these claims are not obvious unless all of the limitations found in the claims are taught or suggested by the prior art. *See* MPEP §2143. In the present case, independent claim 25 includes the limitation that "the conflict between the selected application program and the software code is confirmed after the loading or execution of the software code has been detected." As explained above, this limitation is not taught or suggested by either Shipley, Saboff or Barritz.

Likewise, Applicants can find no teaching in Yinger that relates to this limitation. Accordingly, because none of the cited references teach or suggest this limitation, this combination of references does not render claim 25 prima facie obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.
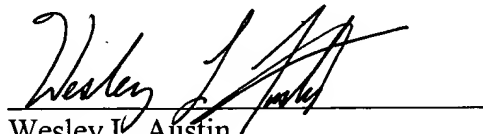
Further, with respect to claims 27-30, these claims depend, either directly or indirectly, from independent claim 25. Accordingly, Applicants respectfully request that the rejection of these dependent claims based upon the combination of Shipley, Saboff, Barritz and Yinger, be withdrawn for at least the same reasons as those presented above in connection with claim 25.

Thus, for the foregoing reasons, Applicants respectfully request that the above-recited rejections be withdrawn.

III. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: September 12, 2005

MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700